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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/017,490

12/14/2001

Daniel P. Segall

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04/02/2003

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EXAMINER

NGUYEN, CHAU N

ART UNIT

PAPER NUMBER

2831

DATE MAILED: 04/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,490

Applicant(s)

SEGALL ET AL.

Examiner

Chau N Nguyen

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspond nc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 13-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Withdrawal of Allowability

The indicated allowability of claims 4 and 6-8 is withdrawn in view of the newly discovered reference(s) to Wagner (WO 97/37054). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wagner (WO 97/37054).

Wagner discloses an electrically conductive multilayer composite comprising first and second polymeric films, each of the films being flexible and having upper and lower surfaces, the second film being thermoformable at temperature at and above its glass transition temperature, a flexible electrically conductive layer applied to the upper surface of the first film, and an adhesive

interlayer adhering the lower surface of the first film to the upper surface of the second film, the adhesive interlayer having elastic properties sufficient to accommodate relative movement between the thus adhered films occasioned by flexure of the composite (re claim 1). Wagner also discloses the second film being resilient (polyester) (re claim 2) and the conductive layer being interfacially fixed with respect to the upper surface of the first film (re claim 12).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35

U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 3, 5-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner.

Claims 3 and 5 in addition to the limitations of claim 1 recite the adhesive interlayer having elastic properties at temperature between about -50 to 150 degrees C and being a pressure sensitive adhesive. Although not disclosed by Wagner, it would have been obvious to one skilled in the art to choose suitable elastic properties for the adhesive interlayer of Wagner to meet the specific use of the resulting composite since it has been held that where the general conditions of a claim are disclosed in prior art, discovering the optimum or workable range involves only routine skill in the art. In re Aller, 105 USPQ 233.

Re claims 6 and 11, Wagner discloses the second film being polyester or polyethylene but does not disclose the first film being made of polyester, polyurethane, polyamides, or polyimides. However, it would have been obvious to one skilled in the art to use polyurethane, polyamides or polyimides for the first film of Wagner since these materials are known in the art for being used as polymeric films in multilayer composites.

Re claim 7, it would have been obvious to one skilled in the art to use a second adhesive layer to adhere another (a third) layer of polymeric film to the lower surface of the second film to increase the thickness of the composite to meet the specific use of the resulting composite since it has been held that merely duplicating the essential working part of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Re claim 8, it would have been obvious to one skilled in the art to provide another (a second) conductive layer opposite to the first conductive layer such that the modified composite of Wagner can be used as a shielding tape with an improved shielding effect (two metal layers in the composite) since it has been held that merely duplicating the essential working part of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

6. Claims 4, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner in view of Bow.

Claims 4, 9 and 10 additionally recite the conductive layer being an aluminum layer having a thickness of not more than 20 mils and adhered to the upper surface of the first film by a second adhesive layer. Bow discloses a composite comprising a conductive layer (12) which is an aluminum layer, has a thickness of not more than 20 mils, and adhered to a polymeric layer by an adhesive layer (24). It would have been obvious to one skilled in the art to apply the teaching of Bow in the composite of Wagner since aluminum is well-known for its relatively high conductivity, and the conductive layer is adhesively bonded to the film.

Response to Arguments

7. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau N Nguyen whose telephone number is 308-0693. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (703) 308 3682. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305 3432 for regular communications and (703) 305 1341 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Chau N Nguyen
Primary Examiner
Art Unit 2831